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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/285,700	04/05/1999	YASUO NISHIDA	P17762	4029
7055	7590	03/30/2004	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			POKRZYWA, JOSEPH R	
		ART UNIT	PAPER NUMBER	
		2622	DATE MAILED: 03/30/2004	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/285,700	NISHIDA ET AL.
Examiner	Art Unit	
Joseph R. Pokrzywa	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12 January 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 53,54,56-61 and 63-75 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 53,54,56-61 and 63-75 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 1/12/04, and has been entered and made of record. Currently, **claims 53, 54, 56-61, and 63-75** are pending.

Response to Arguments

2. Applicant's arguments, seen in pages 9-16, filed 1/12/04, with respect to the rejection(s) of **claims 53, 59-61, and 66** under 35 U.S.C. 103(a), as being unpatentable over Williams *et al.* (U.S. Patent Number 6,192,045) in view of Suzuki (U.S. Patent Number 6,005,677), have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. The examiner concedes that Williams teaches of immediately terminating the telephone line, thereby having no indication that a facsimile protocol transmission is performed, and Suzuki does not specifically teach of disconnecting a facsimile communication when information in a non-standard signal is detected. Thus, the feature of disconnecting facsimile communication upon detecting the capability information in non-standard signal is not specifically taught in the references. However, upon further consideration, a new ground(s) of rejection is made in view of the newly found reference of Maeda (U.S. Patent Number 6,690,480). A full discussion appears below.

Claim Objections

3. **Claim 75** is objected to because of the following informalities:

in *claim 75*, line 2, “the destination terminal” should read one of “the receiving terminal”, “the facsimile sender”, or “the communication terminal”.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 53, 54, 56, 57, 59-61, 63, 64, and 66-75** are rejected under 35 U.S.C. 102(e) as being anticipated by Maeda (U.S. Patent Number 6,690,480).

Regarding *claim 53*, Maeda discloses a communication apparatus (Internet fax apparatus 1, seen in Fig. 1) comprising a facsimile communicator that performs a facsimile communication with a facsimile destination via a telephone network (telephone network 3, column 9, line 43 through column 10, line 25), a communicator that performs electronic mail communication with a destination terminal via a computer network (Internet 4, column 9, line 43 through column 10, line 25), a detector that detects identification information included in a non-standard signal which is transmitted from the facsimile destination while the facsimile communicator performs a facsimile protocol transmission to the facsimile destination (step S71 in Fig. 14, column 18, lines

13 through 67), the identification information indicating that a facsimile destination is capable of electronic mail communication (Internet fax function, in step S73, column 18, lines 13 through 67), and a facsimile communication controller that disconnects the facsimile communication when the detector detects the identification information in the non-standard signal (step S180 in Fig. 14, column 18, lines 19 through 34, and column 19, lines 1 through 16).

Regarding *claim 54*, Maeda discloses the apparatus discussed above in claim 53, and further teaches of a memory that is configured to store the identification associated with the facsimile destination (RAM 12, column 10, lines 17 through 64).

Regarding *claim 56*, Maeda discloses the apparatus discussed above in claim 53, and further teaches that the communicator starts to perform the Internet communication with the facsimile destination upon disconnection of the facsimile communication (step S181 in Fig. 14, column 19, lines 7 through 20).

Regarding *claim 57*, Maeda disclose the apparatus discussed above in claim 53, and further teaches that the non-standard signal includes capability information of the facsimile destination (column 6, lines 12 through 22, and column 10, lines 34 through 50).

Regarding *claim 59*, Maeda discloses a communication apparatus (Internet fax apparatus 1, seen in Fig. 1) comprising a facsimile communicator that performs a facsimile communication with a facsimile destination via a telephone network (telephone network 3, column 9, line 43 through column 10, line 25), an electronic mail communicator that performs electronic mail communication with a destination terminal via a computer network (Internet 4, column 9, line 43 through column 10, line 25), an obtainer that obtains an electronic mail address of the facsimile destination, included in a non-standard signal which is transmitted from the facsimile destination

while the facsimile communicator performs a facsimile protocol transmission to the facsimile destination (column 18, line 22 through column 19, line 16), when the facsimile destination with which the facsimile communication section performs the facsimile communication, is capable of electronic mail communication (step S71 in Fig. 14, column 18, lines 13 through 67), and a facsimile communication controller that disconnects the facsimile communication when the obtainer obtains the electronic mail address of the facsimile destination (step S180 in Fig. 14, column 18, lines 19 through 34, and column 19, lines 1 through 16).

Regarding *claim 60*, Maeda discloses a communication apparatus (Internet fax apparatus 2, seen in Figs. 1 and 15, column 9, lines 43 through 54) comprising a facsimile communicator that performs a facsimile communication with a facsimile sender via a telephone network (column 9, line 55 through column 10, line 25), an electronic mail communicator that performs electronic mail communication with a communication terminal via a computer network (column 9, line 55 through column 10, line 25), and an adder that adds identification information to a non-standard signal which the facsimile communicator transmits to the facsimile sender during a facsimile protocol communication (steps S82-S85 in Fig. 15, column 19, lines 21 through 33), the identification information indicating that a communication apparatus is capable of electronic mail communication (Internet fax function, column 19, lines 27 through 33), detection of the identification information disconnecting a facsimile communication (steps S99 and S100 in Fig. 15, column 19, lines 34 through 43).

Regarding *claim 61*, Maeda discloses a method for identifying a destination terminal (see abstract and Fig. 14), the method comprising performing a facsimile communication with a facsimile destination terminal via a telephone network (telephone network 3, column 9, line 43

through column 10, line 25), detecting whether identification information is included in a non-standard signal which is transmitted from the facsimile destination terminal while a facsimile protocol transmission is performed with the destination terminal (step S71 in Fig. 14, column 18, lines 13 through 67), the identification information indicating that the destination terminal is capable of an electronic mail communication (Internet fax function, in step S73, column 18, lines 13 through 67), storing the identification information when the identification information is detected (step S174, column 18, lines 22 through 67), and disconnecting the facsimile communication when the detecting detects the identification information in the non-standard signal (step S180 in Fig. 14, column 18, lines 19 through 34, and column 19, lines 1 through 16).

Regarding *claim 63*, Maeda discloses the method discussed above in claim 62, and further teaches of initiating an Internet communication with the facsimile destination after the facsimile communication is disconnected (step S181 in Fig. 14, column 19, lines 7 through 20).

Regarding *claim 64*, Maeda discloses the method discussed above in claim 61, and further teaches that the non-standard signal includes capability information of the facsimile destination (column 6, lines 12 through 22, and column 10, lines 34 through 50).

Regarding *claim 66*, Maeda discloses a method for transmitting an electronic mail communication function capability from a receiving terminal to a facsimile sender (see Fig. 15), the receiving terminal having an electronic mail communication section that performs electronic mail communication with a communication terminal via a computer network (see abstract, Fig. 1, and column 9, lines 43 through 54), the method comprising performing a facsimile communication with the facsimile sender via a telephone network (column 9, line 55 through column 10, line 25), and adding identification information to a non-standard signal included in a

facsimile protocol transmission while the facsimile protocol is performed with the facsimile sender (steps S82-S85 in Fig. 15, column 19, lines 21 through 33), the identification information indicating that the communication apparatus is capable of electronic mail communication (Internet fax function, column 19, lines 27 through 33), detection of the identification information disconnecting a facsimile communication (steps S99 and S100 in Fig. 15, column 19, lines 34 through 43).

Regarding **claim 67**, Maeda discloses the apparatus discussed above in claim 53, and further teaches that the detector detects the identification information, the electronic mail communicator performs electronic mail communication with the facsimile destination upon disconnection of the facsimile communication, and when the detector does not detect the identification information, the facsimile communicator performs facsimile communication with the facsimile destination (column 18, line 39 through column 19, line 20).

Regarding **claim 68**, Maeda discloses the apparatus discussed above in claim 59, and further teaches that the obtainer obtains the electronic mail address of the facsimile destination, the electronic mail communicator performs electronic mail communication with the facsimile destination upon disconnection of the facsimile communication, and when the obtainer does not obtain the electronic mail address of the facsimile destination, the facsimile communicator performs facsimile communication with the facsimile destination (column 18, line 39 through column 19, line 20).

Regarding **claim 69**, Maeda discloses the apparatus discussed above in claim 60, and further teaches that when the identification information is detected, the facsimile communication is disconnected and the electronic mail communicator performs electronic mail communication

with the facsimile sender, and when the identification information is not detected, the facsimile communicator performs facsimile communication with the facsimile sender (column 19, lines 21 through 67).

Regarding *claim 70*, Maeda discloses the method discussed above in claim 61, and further teaches that when the detecting does not detect the identification information, transmission via a facsimile communication with the destination is performed (column 18, line 39 through column 19, line 20).

Regarding *claim 71*, Maeda discloses the method discussed above in claim 66, and further teaches that upon detection of the identification information and disconnection of the facsimile communication, an electronic mail communication is performed with the receiving terminal and when the identification information is not detected, a facsimile communication with a facsimile sender is performed (column 19, lines 21 through 67).

Regarding *claim 72*, Maeda discloses the apparatus discussed above in claim 59, and further teaches that the electronic mail communicator performs an electronic mail communication with the facsimile destination upon disconnection of the facsimile communication in response to obtaining of the electronic mail address of the facsimile destination (column 18, line 39 through column 19, line 20).

Regarding *claim 73*, Maeda discloses the apparatus discussed above in claim 60, and further teaches that the electronic mail communicator performs the electronic mail communication with the facsimile sender upon disconnection of the facsimile communication (column 19, lines 21 through 67).

Regarding *claim 74*, Maeda discloses the method discussed above in claim 61, and further teaches of performing an electronic mail communication with the destination terminal upon disconnection of the facsimile communication (column 18, line 39 through column 19, line 20).

Regarding *claim 75*, Maeda discloses the method discussed above in claim 66, and further teaches of performing an electronic mail communication with the receiving terminal upon disconnection of the facsimile communication (column 19, lines 21 through 67).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 58 and 65** are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda (U.S. Patent Number 6,690,480), in view of Fite, Jr. *et al.* (U.S. Patent Number 5,517,324, cited in the Office action dated 8/12/03).

Regarding *claims 58 and 65*, Maeda discloses the apparatus and method discussed above in claims 57 and 64, respectively, and further teaches that the capability information includes at least a coding system (as seen in Figs. 2 and 9). However, Maeda fails to specifically teach if the capability information includes at least resolution, print paper size, and coding system. Fite discloses a communication apparatus (fax machine 12, see Fig. 1, column 4, lines 50 through 66) comprising a facsimile communicator that performs a facsimile communication with a facsimile

destination via a telephone network (column 4, lines 42 through 49), an electronic mail communicator that performs electronic mail communication with a destination terminal (column 4, lines 57 through 66), and a detector that detects identification information included in a non-standard signal which is transmitted from a facsimile destination while the facsimile communicator performs a facsimile protocol transmission to the facsimile destination (column 11, lines 56 through 67). Further, Fite teaches that the non-standard signal includes capability information of the facsimile destination (column 11, lines 56 through 67, and column 7, line 21 through column 8, line 34), and that the capability information includes at least resolution (column 3, lines 2 through 12, column 5, lines 3 through 24, and column 7, lines 1 through 20), print paper size (column 3, lines 2 through 12, column 5, lines 3 through 24, and column 7, lines 1 through 20), and coding system (column 5, line 3 through column 6, line 11, and column 7, lines 1 through 20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Fite's teachings in the system of Maeda. Maeda's system would easily be modified to include the teachings of Fite, since the systems share cumulative features, being additive in nature.

Citation of Pertinent Prior Art

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Suzuki et al. (U.S. Patent Number 6,021,186) discloses a system that disconnects a telephone line after detection of a non-standard signal; and

Fukui et al. (U.S. Patent Number 5,455,687) discloses a system that transmits data to a standard facsimile machine or to an electronic filing system, depending on capability information detected in a non-standard signal.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp

